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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/892,287	06/26/2001	Jennifer L. Hillman	PF-0334-2 DIV	2779
27904	7590	02/28/2005	EXAMINER	
INCYTE CORPORATION EXPERIMENTAL STATION ROUTE 141 & HENRY CLAY ROAD BLDG. E336 WILMINGTON, DE 19880			NOLAN, PATRICK J	
			ART UNIT	PAPER NUMBER
			1644	
DATE MAILED: 02/28/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/892,287	Applicant(s) HILLMAN ET AL.	
	Examiner Patrick J. Nolan	Art Unit 1644	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11 and 30-45 is/are pending in the application:
 4a) Of the above claim(s) 30,33,35,44 and 45 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11,31,32,34 and 36-43 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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1. Applicant's amendments, filed 9-30-04 are acknowledged.

Claims 1-10, 12-29 and 46-47 have been cancelled previously. Claims 11 and 30-45 are pending.

2. Claims 30, 33, 35 and 44-45 stand withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction requirement in Paper No. 7.

3. In view of the rejections set forth below, the issue of rejoinder of claims 30, 33, 35 and 44-45 is held in abeyance.

4. Claims 30, 33, 35 and 44-45 are withdrawn from further consideration by the examiner, 37 C.F.R. § 1.142(b) as being drawn to nonelected inventions.

Claims 11, 31-32, 34 and 36-43 are under consideration in the instant application.

Claim Rejections – 35 U.S.C. § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor

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and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 37-38 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Laxminarayan et al. (J. Biol. Chem. 1993; 268:4968-4974, of record) in view of GenBank Accession #AAB03214 (Nussbaum, R.L., (GI 1399101, GenBank Sequence Database, Accession No. AAB03214, National Center for Biotechnology Information, National Library of Medicine, Bethesda, MD 20894, Release Date 29 June 1996, Version AAB03214.1, of record), as evidenced by the alignment previously provided, for reasons set forth in the Paper mailed 8-26-03.

7. Claims 40-41 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Palmer et al. (J. Biol. Chem. 1994; 269(5):3403-3410, of record) in view of GenBank Accession #AAB03214 (Nussbaum, R.L., (GI 1399101, GenBank Sequence Database, Accession No. AAB03214, National Center for Biotechnology Information, National Library of Medicine, Bethesda, MD 20894, Release Date 29 June 1996, Version AAB03214.1, of record), as evidenced by the previously provided alignment, for reasons of record set forth in the Paper mailed 8-26-03.

8. Claims 11, 31-32, 34 and 42-43 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Palmer et al. (J. Biol. Chem. 1994; 269(5):3403-3410, of record) in view of GenBank Accession #AAB03214 (Nussbaum, R.L., (GI 1399101, GenBank Sequence Database, Accession No. AAB03214, National Center for Biotechnology Information, National Library of Medicine, Bethesda, MD 20894, Release Date 29 June 1996, Version AAB03214.1, of record), as evidenced by the alignment provided previously, and as evidenced by Bost et al. (Immunol. Invest. 1988; 17:577-586) and Bendayan (J. Histochem. Cytochem. 1995; 43:881-886), and further in view of Ramakrishnan et al. (US Pat. No. 5,817,310, of record), for reasons set forth in the Paper mailed 8-26-03.

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Applicant's arguments filed 9-30-04 have been fully considered but are not found persuasive.

Applicant's argues the prior art does not disclose Applicant's claimed polypeptides and since the claims are drawn to to an antibody which specifically binds to a polypeptide comprising SEQ ID NO. 1 or a polypeptide comprising an amino acid sequence at least 95% identical over the full length to SEQ ID NO. 1, the claimed invention is not obvious over the cited publications.

The claims are drawn to a genus of antibodies that specifically bind to proteins that are 95% identical to SEQ ID NO. 1. Included in the scope of this claim are any antibody which specifically recognizes an epitope on SEQ ID NO. 1 and therefore will bind the protein encompassing the epitope specifically. When two proteins have the same epitope, an antibody made against one protein will result in an antibody that specifically binds both proteins. Applicant is invited to review Kuby, Immunology, submitted in the last office action. So, the prior art protein, is identical in 326 out of 328 amino acids to applicant's claimed SEQ ID NO. 1. Kuby teaches that antibodies recognize epitopes in proteins that are in general 15-22 amino acids long. So one of skill in the art would expect that upon immunization of the prior art protein, multiple epitopes recognized by antibodies generated by the immunization methods taught by the prior art, will be 100% identical between the prior art protein and Applicant's claimed SEQ ID NO. 1. As such the antibodies made obvious by the prior art would be expected to specifically bind both the prior art protein and the claimed protein.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 36 and 39 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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It is unclear what the metes and bounds are of the term “naturally occurring” is in claims 36 and 39. Science has not even finished isolating all naturally occurring organisms, so the term naturally occurring is constantly being amended by the isolation of new organisms and the amino acid sequences they encompass in their proteome.

10. Claims 11, 32, 39 and 42 are objected to because of the following informalities: In claim 11, the removal of “to the” in line 5 and “having” in line 6 make the claim awkward. Also an insertion “an” after comprising is suggested. In claim 32, the claim starts with a lower case “a”. In claim 39, line 6, activity is recited twice in a row. In claim 42, the claim starts with a lower case “the”. Lastly in non-examined withdrawn claim 45, it starts with a lower case “a”. Appropriate correction is required.

11. The fax number for the organization where this application or proceeding is assigned is 703-872-9306.

12. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick Nolan whose telephone number is 571-272-0847.

If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Christina Chan, can be reached at 571-272-0841.

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A handwritten signature in black ink, appearing to read "Patrick J. Nolan".

Patrick J. Nolan, Ph.D.

Primary Examiner, Group 1640

February 22, 2005